

REMARKS

Applicant respectfully requests reconsideration and allowance of the subject application in view of the foregoing amendments and the following remarks.

Claims 9-17 and 23-32 are pending in the application, with claims 9, 16, 17, and 26 being independent. Claims 1-8 are canceled herein without prejudice to or disclaimer of the subject matter recited therein. Claims 13 and 25 are amended and claims 26-32 are newly added. Support for the claim amendments and additions can be found in the original disclosure at least at original claim 9, paragraphs [0017], [0021]-[0023], and [0027]-[0030], and FIGS. 1-4. Therefore, no new matter has been added.

Drawing Objections

In the Office Action, the drawings were objected to for failing to show the following features recited in the claims:

- I. “the first foot portion has only one aperture therethrough” (claims 10, 16, and 17),
- II. “at least three apertures through the interconnecting portion corresponding to and aligned with the apertures of the first and second foot portions” (claims 16 and 17), and
- III. “at least three apertures through the interconnecting portion substantially axially parallel to and aligned with the apertures of the first and second foot portions” (claim 9).

These objections are respectfully traversed. Nevertheless, without conceding the propriety of the objections, and to expedite allowance of the application, FIGS. 3 and 4 are amended herein to illustrate each of the foregoing features.

Specification Objections

The specification was objected to for failing to provide proper antecedent basis for the claimed subject matter of items II and III above. In the interest of expediting prosecution, the specification has been amended at paragraph [0025] to include the features of items II and III above. Support for this amendment can be found in the original disclosure at least in original claim 9 and FIG. 2.

Claim Objections

Claims 8, 13, and 25 were objected to for a perceived “uncertainty as to what each/all of the specific alternatives [recited in those claims] can be” (Office Action, page 5). This objection is respectfully traversed. Nevertheless, without conceding the propriety of the objection, claim 8 has been canceled without prejudice, and claims 13 and 25 have been amended, thereby obviating the objection.

Art Rejections

The Office Action issued new grounds of rejection as follows:

Claims 1-4, and 8 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,932,844 (McAller et al.). This rejection is respectfully traversed. Nevertheless, without conceding the propriety of the rejection, claims 1-4 and 8 have been canceled herein without prejudice to or disclaimer of the subject matter recited therein, thereby rendering the rejection of those claims moot.

Claims 1-5, 8-15, 17, and 23-25 were rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 647,169 (Vogel) in view of U.S. Patent No. 389,660 (Mandel et al.) and U.S. Patent No. 4,720,260 (Yamaguchi). This rejection is respectfully traversed at least because (1) there is no motivation to combine the documents as suggested in the office action and, (2) even if, for the sake of argument, the documents could be combined, the combination still lacks features of the independent claims. Nevertheless, without conceding the propriety of the rejection, claims 1-5 and 8 are canceled herein without prejudice, thereby rendering the rejection of those claims moot.

(1) One of ordinary skill in the art would not have been motivated to combine the documents as suggested in the Office Action. “In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned.” MPEP § 2141.01(a)(quoting *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992)). In this case, Yamaguchi is neither in the field of Applicant's endeavor, nor pertinent to the problem with which the inventor was concerned. Accordingly, one of ordinary skill in the art would not have been motivated to combine the teachings of Yamaguchi with those of the other cited documents.

Yamaguchi is not in the field of Applicant's endeavor. As described in paragraph [0001] of the subject application, the “invention generally and in various embodiments relates to devices for retaining and protecting wires, and more particularly to wire protecting apparatuses for use in retaining wire in an environment where wires may otherwise become damaged by fasteners.” This is consistent with the preamble of claim 9, which recites “[a]n apparatus for protecting and retaining a wire” Yamaguchi has nothing whatsoever to do with devices for retaining and

protecting wires. Instead, Yamaguchi is directed to the non-analogous field of burning wicks for oil burning apparatus.

Yamaguchi is also not pertinent to the problem with which the inventor was concerned. As noted above, the inventor was concerned with retaining and protecting wires. Yamaguchi's teaching that "a plurality of circular holes 10 are punched out from the binder body 7a ..." of a wick binder element is not reasonably pertinent to the problem of retaining and protecting wires, or any other problem with which the inventors of the subject application were concerned.

Accordingly, Applicant requests reconsideration and withdrawal of all of the rejections based on Yamaguchi.

(2) Even if, for the sake of argument, the documents could be combined as suggested in the Office Action, the combination still would lack features of each of the independent claims.

Independent claim 9 is directed to an apparatus for protecting and retaining a wire, and recites, among other things, a first foot portion having at least one aperture therethrough; a second foot portion having at least two apertures therethrough; and an interconnecting portion connecting the first foot portion to the second foot portion [with] at least three apertures through the interconnecting portion substantially axially parallel to and aligned with the apertures of the first and second foot portions.

Vogel discloses a fastener for rods or pipes, the fastener including a plate P perforated at the ends with holes h and h' to receive prongs p with heads H (col. 2, lines 55-80).

Mandel et al. discloses a metallic fastener comprising a yoke 3 having two holes 4 near its ends, and an ordinary staple 1, the legs 2 of which register with the holes 4 in the yoke 3. The yoke 3 also includes a longitudinal slot 5 along its middle portion, into which the bent ends of the legs 2 of the staple 1 are turned and snugly fitted when clinched.

However, as acknowledged on pages 9 and 10 of the Office Action, neither Vogel nor Mandel et al. discloses or suggests “an interconnecting portion connecting the first foot portion to the second foot portion [with] at least three apertures through the interconnecting portion substantially axially parallel to and aligned with the apertures of the first and second foot portions,” as presently recited in independent claim 9.

The Office Action asserts that this feature is met by Yamaguchi, and states on page 10 that “Yamaguchi suggest placing at least three axially aligned apertures in an ‘interconnecting portion’ in order to provide an ornamental and decorative appearance, and to further lighten the overall weight of the fastener.” As discussed above, one of ordinary skill in the fastener art would have had no motivation to look to the burning wick art of Yamaguchi to modify the fasteners of Vogel or Mandel et al. However, even if, for the sake of argument, the cited documents could be combined as suggested, the combination still fails to disclose or suggest “at least three apertures through the interconnecting portion substantially axially parallel to and aligned with the apertures of the first and second foot portions,” as recited in independent claim 9. In particular, Yamaguchi does not even disclose first and second foot portions with apertures therethrough. Therefore, Yamaguchi cannot be said to disclose or suggest “at least three apertures through an interconnecting portion” that are “axially parallel to and aligned with the apertures of the first and second foot portions.” Nor do the other cited documents teach or suggest “at least three apertures through an interconnecting portion” that are “axially parallel to and aligned with the apertures of the first and second foot portions,” as recited in claim 9.

Accordingly, independent claim 9 is allowable over the cited documents for at least this additional reason.

Independent claim 17 is also directed to an apparatus for protecting and retaining a wire, and recites, among other things, at least three apertures through the interconnecting portion corresponding to and aligned with the apertures of the first and second foot portions. Accordingly, independent claim 17 is allowable for reasons similar to those discussed above with respect to independent claim 9.

Dependent claims 10-15 and 23-25 depend from one of claims 9 and 17 and are, therefore, allowable by virtue of this dependency, as well as for the additional features that they recite.

For example, **dependent claim 12** recites that “the at least one fastener is integrated within the single body and extends outward therefrom.” None of the cited documents has been shown to disclose or suggest such a feature. The Office Action does not even address this feature. Accordingly, claim 12 is allowable for at least this additional reason. Individual consideration of each dependent claim is respectfully requested.

Claims 6, 7, and 16 were rejected under 35 U.S.C. § 103(a) as being obvious over Vogel in view of Mandel et al. and Yamaguchi, and further in view of U.S. Patent No. 2,522,656 (Whalen). This rejection is respectfully traversed. Nevertheless, without conceding the propriety of the rejection, claims 6 and 7 are canceled herein without prejudice, thereby rendering the rejection of those claims moot.

Initially, Applicant notes that this rejection is based in part on Yamaguchi. As discussed above, one of ordinary skill in the art would not have been motivated to combine the teachings of Yamaguchi with those of the other cited documents, since Yamaguchi is in the non-analogous burning wick art.

Moreover, even if, for the sake of argument, the documents could be combined as suggested in the Office Action, the combination still would lack features of independent claim 16. In particular, **independent claim 16** is directed to an apparatus for protecting and retaining a wire, and recites, among other things, at least three apertures through the interconnecting portion corresponding to and aligned with the apertures of the first and second foot portions. Accordingly, independent claim 16 is allowable for reasons similar to those discussed above with respect to independent claim 9.

Claims 1-4 and 8 were rejected under 35 U.S.C. § 102(b) as being anticipated by, or alternatively under 35 U.S.C. § 103(a) as being obvious over, U.S. Patent No. 5,314,160 (Larsen). This rejection is respectfully traversed. Nevertheless, without conceding the propriety of the rejection, claims 1-4 and 8 are canceled herein without prejudice, thereby rendering the rejection of those claims moot.

Claims 1, 3, 4, 6-17, and 23-25 were rejected under 35 U.S.C. § 102(b) as being anticipated by, or alternatively under 35 U.S.C. § 103(a) as being obvious over, U.S. Patent No. 3,341,651 (Odegaard). This rejection is respectfully traversed. Nevertheless, without conceding the propriety of the rejection, claims 1, 3, 4, and 6-8 are canceled herein without prejudice, thereby rendering the rejection of those claims moot.

Independent claim 9 is directed to an apparatus for protecting and retaining a wire, and recites, among other things, that the first foot portion, the second foot portion and the interconnecting portion form a passage beneath the interconnecting portion and between the first foot portion and the second foot portion adapted to receive the wire and retain the wire between

the interconnecting portion and a mounting structure. Odegaard fails to disclose or suggest such features.

Odegaard is directed to a cable or wire securing device, and discloses at column 2, lines 60-66 (with reference to Figs. 4-7) that:

a bar 10 is bent into a U-shape about the transverse axis A—A to receive in recess 22 a cable 54 ... the portions of the inner face 14 on each side of the transverse axis A—A are brought into opposed contacting relationship such as to clampingly confine the cable 54 within the recess 22 which becomes arcuate in form.

Thus, in Odegaard, the securing device is not “adapted to receive the wire and retain the wire between the interconnecting portion and a mounting structure,” as presently recited in independent claim 9. Rather, the securing device of Odegaard bends into a U-shape to clampingly confine the cable within an internal recess.

Accordingly, independent claim 9 is allowable over Odegaard for at least these reasons.

Independent claim 16 is also directed to an apparatus for protecting and retaining a wire, and recites, among other things, that the first foot portion, the second foot portion and the interconnecting portion form a passage beneath the interconnecting portion and between the first foot portion and the second foot portion adapted to receive the wire and retain the wire between the interconnecting portion and a mounting structure. Accordingly, independent claim 16 is allowable for reasons similar to those discussed above with respect to independent claim 9.

Independent claim 17 is also directed to an apparatus for protecting and retaining a wire, and recites, among other things, that the first foot portion, the second foot portion and the interconnecting portion form a passage beneath the interconnecting portion and between the first foot portion and the second foot portion adapted to receive the wire and retain the wire between

the interconnecting portion and a mounting structure. Accordingly, independent claim 17 is allowable for reasons similar to those discussed above with respect to independent claim 9.

Dependent claims 10-15 and 23-25 depend from one of claims 9 and 17 and are, therefore, allowable by virtue of this dependency, as well as for the additional features that they recite.

New claims 26-32 recite additional features which are neither disclosed nor suggested by the cited documents. For example, new **independent claim 26** is directed to a retainer and recites:

a molded polymeric body comprising:

first and second foot portions at opposed ends of the body, the first foot portion having at least one aperture and the second foot portion having at least two apertures;

an interconnecting portion between the first and second foot portions, the interconnecting portion and foot portions define a passage beneath the interconnecting portion and between the first foot portion and the second foot portion adapted to receive a wire and retain the wire between the interconnecting portion and a mounting structure to which the retainer can be secured; and

indicia on the body relating fastener sizes to the apertures;

and

a staple received in an aperture of the first foot portion and an aperture of the second foot portion, for securing the retainer to the mounting structure.

None of the cited documents discloses such features. Accordingly, independent claim 26 is allowable over the cited documents.

New dependent claims 27-32 depend from claim 26 and are, therefore, allowable by virtue of this dependency, as well as for the additional features that they recite.

For example, new **dependent claim 27** recites that “the polymeric body has a first side, which is closest to the mounting structure when the retainer is secured to the mounting structure, and a second side, which is furthest from the mounting structure when the retainer is mounted to

the mounting structure” and that “a thickness between the first and second sides is greater for the first and second foot portions than for the interconnecting portion.” None of the cited documents disclose such features. Accordingly, claim 27 is allowable for at least these additional reasons.

Dependent claim 28 recites that “at least three apertures through the interconnecting portion corresponding to and aligned with the apertures of the first and second foot portions; and at least one of protruding grips and grooves disposed on outer edges of the opposed ends of the polymeric body, wherein the indicia are disposed on a top surface of the polymeric body and identify at least one of a size of the staple and a size of the retainer on which the indicia are placed, and wherein the staple is integrated into the polymeric body, such that prongs of the staple extend outward from the polymeric body.” None of the cited documents disclose such features. Accordingly, claim 28 is allowable for at least these additional reasons.

Conclusion

For at least the foregoing reasons, claims 9-17 and 23-32 are in condition for allowance. Applicants respectfully request reconsideration and withdrawal of the objections and rejections, and an early notice of allowance.

If any issue remains unresolved that would prevent allowance of this case, **the Examiner is requested to contact the undersigned attorney to resolve the issue.**

Respectfully submitted,

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By: 

David A. Divine
Lee & Hayes, PLLC
Reg. No. 51,275
(509) 324-9256 ext. 233